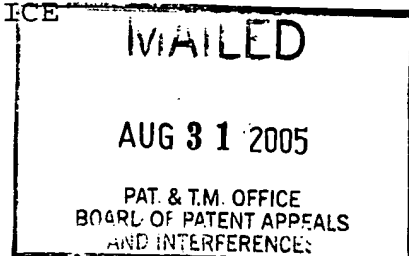


The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES



Ex parte MARTIN W. MASTERS, MATTHEW PIETRAFITTA,  
and THERESE VELDE

Appeal No. 2005-2324  
Application No. 09/944,315

HEARD: Aug. 10, 2005

Before WALTZ, KRATZ, and PAWLIKOWSKI, Administrative Patent Judges.

WALTZ, Administrative Patent Judge.

**DECISION ON APPEAL**

This is a decision on an appeal from the primary examiner's final rejection of claims 1 through 19, which are the only claims pending in this application. We have jurisdiction pursuant to 35 U.S.C. § 134.

According to appellants, the invention is directed to giving a textured, non-smooth finish to the outer surface of a hearing instrument shell to prevent the hearing instrument from slipping

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out of the ear and to create an outward appearance that blends with the wearer's ear (Brief, page 2).

Appellants state that the claims fall into three groups and suggest that claims 2 or 8 be relied upon to represent all three groups (Brief, page 2). As correctly noted by the examiner (Answer, page 2, ¶(7)), appellants fail to state that the claims do not stand or fall together, and also fail to present any specific reasons for the separate patentability of any individual claim (see the Reply Brief, page 1). Therefore we select claim 1 as the *broadest* independent claim representative of appellants' invention, and decide the first ground of rejection on appeal on the basis of this claim alone (we also select claim 4 from the second rejection on appeal to the extent that appellants present specific arguments). See 37 CFR § 1.192(c)(7)(2003); *In re McDaniel*, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002). Claim 1 is reproduced below:

1. A textured hearing instrument shell.

The examiner has relied on Widmer et al. (Widmer), U.S. Patent No. 6,401,859 B1, issued Jun. 11, 2002 (filed Sep. 25, 2000), as the sole evidence of unpatentability (although the examiner also takes "official notice" as evidence in the rejection based on section 103(a)). Claims 1-3, 5-6, 8-9 and 11-

19 stand rejected under 35 U.S.C. § 102(e) as anticipated by Widmer (Answer, page 3, referring to the Office action dated Mar. 16, 2004). Claims 4, 7 and 10 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Widmer (Answer at page 4, referring to the Office action dated Mar. 16, 2004).

Based on the totality of the record, including the opposing arguments presented in the Brief, the Reply Brief, the Answer, and the "Detailed Action" dated Jan. 31, 2005, we *affirm* all the rejections on appeal essentially for the reasons stated in the Answer and those reasons set forth below.

#### **OPINION**

##### *A. The Rejection under § 102(e)*

With respect to the subject matter of claim 1 on appeal, the examiner finds that Widmer discloses a textured hearing instrument shell, citing Figures 4 through 24 (Answer, page 3).

Appellants argue that the element missing from Widmer is that of "texture," as defined by appellants in their specification and illustrated by a standard engineering handbook (Brief, page 3). Appellants argue that Widmer does not satisfy the requirements for anticipation as it fails to disclose, teach or suggest creating a surface texture, and does not address the problems of slippage and appearance solved by the texture of

appellants' invention (*id.*). Appellants assert that the "ribs" taught by Widmer are for structural support, and the surface of the shell itself remains smooth and untextured (*id.*). Finally, appellants argue that the examiner's construction of the term "texture" is improper, citing the "Certification" of Mr. Masters and noting that the ribs of Widmer do not create the appearance of "natural skin" (Brief, page 4; Reply Brief, page 2).

It is implicit in our review of the examiner's anticipation analysis that we must first correctly construe the claim to define the meaning and scope of any contested limitations. See *Gechter v. Davidson*, 116 F.3d 1454, 1457, 43 USPQ2d 1030, 1032 (Fed. Cir. 1997). "The Patent and Trademark Office (PTO) determines the scope of claims in patent applications not solely on the basis of claim language, but upon giving claims their broadest reasonable construction 'in light of the specification as it would be interpreted by one of ordinary skill in the art.'" *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. Jul. 12, 2005) (en banc), quoting *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1830 (Fed. Cir. 2004). Of course, limitations from the specification should not be imported into the claims, even if the preferred embodiment is the only embodiment described, absent clear disclaimer in the

specification. See *In re Am. Acad. Of Sci. Tech. Ctr.*, *supra*; see also *Comark Communications, Inc. v. Harris Corp.*, 156 F.3d 1182, 1186-87, 48 USPQ2d 1001, 1005 (Fed. Cir. 1998) ("there is sometimes a fine line between reading a claim in light of the specification and reading a limitation into the claim from the specification").

The only contested claim limitation in this appeal is the claim construction of the term "textured," as it appears in claim 1 on appeal. Accordingly, we must determine the proper meaning and scope of this term. First, we turn to appellants' specification for any definition or guidelines for the term "texture." Appellants teach that the shell of the hearing instrument is provided with a "textured finish" (abstract). Appellants disclose that the texture "may be a series of lines 50, equally or unequally spaced (Figures 3 and 4), or a plurality of shapes (e.g., ovals and circles in Figures 5 and 6, respectively), or some other pattern, predetermined or randomly generated." Specification, page 5, ll. 1-6. Therefore we need not consult any extrinsic evidence, as appellants' specification clearly defines "textured" as a series of lines or shapes in any order or spacing that lie on a surface of the hearing instrument shell. "[T]he specification is always highly relevant to the

claim construction analysis. Usually it is dispositive; it is the single best guide to the meaning of a disputed term."

*Phillips v. AWH Corp.*, 415 F.3d at 1315, 75 USPQ2d at 1327 (internal quotations omitted).

We note that the specific teachings from the specification that the texture may also have the property or characteristic of being "non-smooth" (specification, page 2, l. 8), or that the texture may be applied to the "outer shell" (*id.*), or that the textured finish produces "an appearance closer to that of natural skin" (specification, page 2, ll. 10-11) have not been imported into claim 1 on appeal (see claims 2 and 3 on appeal).

Appellants cite Marks' Standard Handbook for Mechanical Engineers (Marks') on page 6, ll. 14-17, of the specification, for "particulars of surface texture." On page 13-76, Marks' teaches that surfaces that are polished still exhibit a "texture," and thus the broadest reasonable interpretation of "texture" would include smooth and non-smooth texture finishes. Similarly, the broadest reasonable interpretation of "shell" would include both inner and outer surfaces. Finally, we determine that "an appearance closer to that of natural skin" is merely a subjective result of the texture but does not define or limit what a "texture" encompasses. See Marks' at page 13-77.

In view of our claim construction discussed above, we agree with the examiner that at least the ribs 47 of Figure 15 or the ribs 51 of Figure 18 describe a series of lines, unequally spaced, and thus constitute a "textured" surface on the inside and outside of a hearing instrument shell within the scope and meaning of claim 1 on appeal. Therefore we affirm the examiner's rejection of claim 1 on appeal, and claims 2-3, 5-6, 8-9, and 11-19 that stand or fall with claim 1, under 35 U.S.C. § 102(e) over Widmer.

*B. The Rejection under § 103(a)*

The examiner applies Widmer as discussed above, further taking "official notice" that it was known in the art for hearing instruments to be made of a variety of finishes (see claims 4 and 10) and taking "official notice" that it was known to include a textured faceplate onto a hearing instrument (Answer, page 4). As correctly noted by the examiner (Answer, pages 7-8), appellants have not contested either of the "official notices" taken by the examiner (see the Brief, page 4, last paragraph).<sup>1</sup>

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<sup>1</sup>Where a reference is relied on to support a rejection, whether or not in a minor capacity, there would appear to be no excuse for not positively including that reference in the statement of the rejection. See *In re Hoch*, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970). Accordingly, we do not consider the "Westone Laboratories" and "Woodfill, Jr."

(continued...)

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Accordingly, we take the examiner's "official notices" as fact,<sup>2</sup> and adopt the examiner's findings and conclusions of law as stated in the Answer on pages 4-5. Therefore we also affirm the examiner's rejection of claims 4, 7 and 10 under 35 U.S.C. § 103(a) over Widmer.

*C. Other Issues*

We note related Appeal No. 2005-1380 in Application No. 09/944,314 for consideration by the examiner in the event of further or continuing prosecution, including the citation of other prior art which may be relevant to the subject matter in this application.

*D. Summary*

The rejection of claims 1-3, 5-6, 8-9 and 11-19 under 35 U.S.C. § 102(e) as anticipated by Widmer is affirmed. The rejection of claims 4, 7 and 10 under 35 U.S.C. § 103(a) as unpatentable over Widmer is also affirmed.

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<sup>1</sup>(...continued)  
references discussed by the examiner for the first time on pages 7-8 of the Answer.

<sup>2</sup>See *In re Ahlert*, 424 F.2d 1088, 1091-92, 165 USPQ 418, 420-21 (CCPA 1970).




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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv)(2004).

**AFFIRMED**

Thomas A. Waltz  
Thomas A. Waltz  
Administrative Patent Judge

  
Peter F. Kratz  
Administrative Patent Judge

Beverly A. Pawlikowski  
Administrative Patent Judge

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Siemens Corporation  
Intellectual Property Department  
186 Wood Avenue South  
Iselin, NJ 08830